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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,046	02/13/2004	Matthew Lerner	5486-0164PUS1	3923
67321 7590 12/10/2009 BIRCH, STEWART, KOLASCH & BIRCH, LLP PO Box 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
TSUL, WILSON W				
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2178				
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12/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/777,046

**Applicant(s)**

LERNER ET AL.

**Examiner**

WILSON TSUI

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2,5-7,9,10,15,16,21 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 is/are allowed.
- 6) ☒ Claim(s) 2,5-7,9,10,15,16 and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This final action is in response to the amendment filed on: 09/10/09.
2. Claims 1, 3, 4, 8, 11-14, 17-20, and 22-24 are cancelled. Claims 2, 5, 6, 7, 9, 10, 15, and 21 are amended. Claims 27-29 are new. Claims 2, 5-7, 9, 10, 15, 16, 21, 25-29 are pending.
3. Claims 9, 10, 15, and 16 remain rejected under 35 U.S.C. 102(b) as being anticipated by Keely et al.
4. Claims 2, 5, 6, 7, 25-29 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Hardock et al.

***Allowable Subject Matter***

5. Claim 21 is allowed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 9, 10, 15, and 16 remain rejected under 35 U.S.C. 102(b) as being anticipated by Keely et al (US Application: US 2002/0049787, published: Apr. 25, 2002, filed: Dec. 29, 2000).

With regards to claim 9, Keely et al teaches a method of displaying clips comprising the steps of:

*receiving at least two display regions of a document, each display region having a set of an annotation and related content, the at least two display regions being extracted from non-contiguous portions of the document or portions of different documents* (Figure 13, paragraphs 0090-0098: whereas a plurality of sets of annotations can be received.

Additionally specific anchor/region of the document is received/saved along with its related annotation and related context data. This display anchor/region data (having associated annotation and related context data) can be used to display using annotation retrieval/filter criteria, annotation(s) with their related context data);

*combining said at least two display regions to form a combination consisting of non-contiguous portions of the document or portions of different documents or both; filtering said combination of said at least two display regions* (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, display anchor/region data is used to produce/combine clips comprising annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations);

*Rendering an image having said clips, wherein at least one of said clips is a clip having the filtered combination of said at least two display regions; and displaying the clips including the at least one clip having the filtered combination of said at least two display regions* (paragraph 0078, Figure 9: whereas, the image of the clips of data are rendered, such that the clips are displayed).

With regards to claim 10, which depends on claim 9, Keely et al teaches further comprising the step of: *storing said clip as said combination of said at least two display regions* (Figure 8A, Figure 8B: whereas storage is implemented).

With regards to claim 15, Keely et al teaches a computer-readable medium having a program stored thereon, said program for displaying clips and comprising the steps of: *receiving at least two display regions of a document, each display region having a set of an annotation* (Figure 13, paragraphs 0090-0098: whereas a plurality of sets of annotations can be received. Additionally specific anchor/region of the document is received/saved along with its related annotation and related context data. This display anchor/region data (having associated annotation and related context data) can be used to display using annotation retrieval/filter criteria, annotation(s) with their related context data) *and related content, the at least two display regions being extracted from non-contiguous portions of the document or portions of different documents (); combining said at least two display regions to form a combination consisting of non-contiguous portions of the document or portions of different documents or both; filtering said combination of said at least two display regions* (paragraph 0015, 0016, 0075, and 0078, Figure 9: whereas, display anchor/region data is used to produce/combine clips comprising annotations that are filtered per user input, and the clips can comprise a combination of two or more filtered annotations); *and rendering an image having said clips, wherein at least one of said clips is a clip having the filtered combination of said at*

*least two display regions; and displaying the clips including the at least one clip having the filtered combination of said at least two display regions* (paragraph 0078, Figure 9: whereas, the image of the clips of data are rendered, such that the clips are displayed).

With regards to claim 16, which depends on claim 15, Keely et al teaches further comprising the step of: *storing said combination of said at least two sets* (Figure 8A, Figure 8B: whereas storage is implemented).

7. Claims 2, 5, 6, 7, and 25-29 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Hardock et al ("A Marking Based Interface for Collaborative Writing", published: November 5, 1993, publisher: ACM).

With regards to claim 27, Hardock et al teaches a method of displaying clips comprising the steps of:

*Receiving data regarding an annotation which is associated with an active content displayed in a user interface during a current access session, the active content changes between a previous access session and the current access session* (page 260, right column: whereas, received marked up annotations are displayed in a left window and the annotations annotate a document, which is active. The active document being shown in a right window);

*Storing the annotation together with a static image of the active content as displayed in the current access session* (Figure 4: whereas, the annotation is stored and

shown in a static image in a left window. The static image, is a static image of an active document);

*Storing a link to the active content that was displayed in the user interface at the time of the current access session* (Figure 4: whereas, active content/current state of the annotated document is retrieved/linked, such that is the retrieved data is shown in a right window);

*Rendering an image having clips, wherein at least one of said clips is a clip having the stored annotation and static image of the active content* (Figure 4: whereas the clips has a stored annotation and stored static image of the document); *and*

*Displaying the rendered clips, wherein selection of said annotation in said at least one clip accesses the active content via the stored link* (Figure 4, page 260, right column: whereas, a user can point to an annotation in the left view, and the active document is linked for retrieval and displayed in a right window).

With regards to claim 28, for a computer-readable medium having a program stored thereon, the program performing a method similar to the method performed by claim 27, is rejected under similar rationale.

With regards to claim 29, for a system, which performs a method similar to the method performed by claim 27, is rejected under similar rationale.

With regards to claim 2, which depends on claim 29, Hardock et al teaches *wherein said at least one of said clips includes additional content* (Figure 4: whereas a clip is shown having additional content, the additional content can be the text/context data, or additional annotations from other authors/collaborators (page 265, left column)).

With regards to claim 5, which depends on claim 29, Hardock et al teaches further comprising: *a storage storing said annotation and an image of the first content associated with the annotation* (page 260, right column, whereas annotations are returned/saved at primary author's computer).

With regards to claim 6, which depends on claim 29, Hardock et al teaches further comprising: *a storage storing said annotations and a link to said content* (Figure 4: whereas, a link to the active content document, is used to display a document in the right window).

With regards to claim 7, which depends on claim 29, Hardock et al teaches further comprising: *a storage storing said annotation and an active image of the first content associated with the annotation, wherein the first content changes over time* (page 260, right column, Figure 4: whereas, the first content within a document can change over time when changes/revisions are acted upon).



With regards to claim 25, which depends on claim 6, Keely et al teaches *wherein said annotations are from different documents* (Figure 6: whereas annotations can be located on different pages/documents).

With regards to claim 26, which depends on claim 25, Keely et al teaches *wherein said documents are from different application programs* (Figure 1, page 262, right column: whereas documents can be retrieved from different computers, in a distributed environment).

### ***Response to Arguments***

8. Applicant's arguments filed 09/10/09 have been fully considered but they are not persuasive.

9. The applicant first argues with respect to claims 9 and 15, that "unlike, Keely's listing of annotations, as in Fig. 9, the claimed invention works with display regions of a document(s) having an annotation and related content, combines display regions, filters, the display regions, and renders an image including a clip having the filtered combination of display regions (e.g., steps shown in Figs 7 and 8).

However the examiner respectfully disagrees, and points out that Keely's annotations *are marked on a displayed document, and a specific anchor/region of the document is received/saved along with its related annotation and related context data* (paragraphs 0090-0098). This display anchor/region data (having associated annotation and related

context data) can be used to display using annotation retrieval/filter criteria, annotation(s) with their related context data (paragraph 0078, Figure 9).

The examiner notes that the applicant appears to be arguing/implying that the display region, is an *image region within the image of the document that encompasses the annotation and related context data*. Should this be what the applicant is requiring, the examiner emphasizes that this should be clarified in the claim language to expedite the prosecution of the application.

10. The applicant argues with respect to claims 27 and 28, the applicant argues that "unlike Keely, the claimed invention stores a link to the active content, and an image having clips, where one of the clips has the annotation and a static image of the active content is rendered and displayed. The stored link enables access to the active content by selection of the annotation clip.

The examiner respectfully directs the applicant's attention to new grounds of rejection explained above, for how Hardock et al teaches the applicant's new claim limitations.

11. The applicant argues with respect to 29, that it is allowable, for reasons similar to the arguments for claim 27. However, the examiner respectfully disagrees, and respectfully directs the applicant's attention to new grounds of rejection explained above, for how Hardock et al teaches the applicant's new claim limitations.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILSON TSUI** whose telephone number is (571)272-7596. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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